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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

DN 801001

In re the Application of:

Jeffrey P. Szmanda

Serial No.: 09/982,640

Filed: 10/18/2001

For: A Method of Retrieving Advertising
Information and Use of the Method



) Group Art Unit: 2171

) Examiner: Cam-Linn Nguyen


Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF TRANSMITTAL

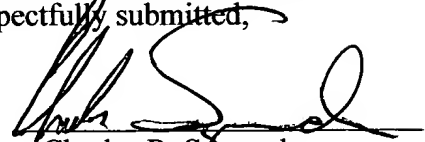
1. Reply Brief – Appeal, 17 pages, excluding cover, (09/982,640, DN 801001)
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26 August, 2006


Charles R. Szmanda

Dated this 26th day of August, 2006
Respectfully submitted,



Charles R. Szmanda
Agent for Appellant
Registration # 48,618
Telephone: 508 836 4143
FAX: 508 836 4143

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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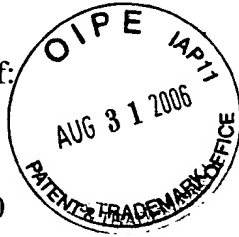
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Reply Brief

Appellant is in receipt of the Examiner's Answer to appellant's appeal brief, mailed 4 August, 2006.

The examiner has given answers to some, but not all of appellant's arguments.

Regarding the presentation of arguments, infra, Arguments 1, 2, 3 and 4 pertain to Claim 1. Arguments 5, 2, 6, 7 and 8 pertain to Claim 11. Arguments 5, 2, 6, 9 and 8 pertain to claim 25 except that the antecedent bases of the subject matter of Argument 8 differ from those of Argument 8 as they pertain to Claim 11. Arguments 10, 2, 3 and 4 pertain to Claim 38 except that the antecedent bases of the subject matter of Arguments 3 and 4 differ from those of Arguments 3 and 4 as they pertain to Claim 1. Arguments 10, 2, 3, 11 and 12 pertain to claim 42 except that the antecedent bases of the subject matter of Argument 3 differ from those of Argument 3 as it pertains to Claims 1 and 39.

Appellant's replies are provided infra in the Examiner's order.

Argument 1: Skillen and Loeb do not disclose: "receiving, from the user, a series of search rules comprising facts about an advertisement" (page 11 and 28 of the Appeal Brief). In the Examiner's Answer, the Examiner alleged that the above cited limitation can be found in the following quotations:

Skillen, column 1, lines 50-57: According to a second broad aspect, the invention provides a method of searching for desired information within a data network, comprising the steps of: receiving, from a user, a search request including a search argument corresponding to the desired information; searching, based upon the received search argument and user profile data, a database of information to generate a search result; and providing the search results to the user.

Skillen, column 1, lines 50-57: 1) The end user device 12 sends a search request outlining the search argument to the database search engine 16.

Skillen, column 2, lines 44-45: In addition to the search criterion, as users interact with the advertising system, it will continue to compile preference data...

The above quotations simply *do not* show that the above listed limitation is contained therein. In fact, Skillen does not disclose expressly or inherently "receiving, from the user, a series of search rules comprising facts about an advertisement" as defined in appellant's specification (Szmanda, page 15-16, lines 22-29, 1-9) in any part of the [Skillen] document. Skillen's user is doing a "traditional search of Internet related information in the contextual data" (Skillen, column 4, lines 31-34) in which *any* information is sought. Indeed, nowhere does Skillen specify exactly what the user is searching for except to say that the user is searching for "information" (column 2, line 30) or "desired information" (Abstract, column 1, lines 40, 51, 59, column 2, line 4, Claim 1).

The Examiner also alleges that the instant claim limitation can be found in Loeb in the passage, reproduced infra:

Loeb, column 9, lines 10-65: The subscription process involves a series of steps through which the system establishes data stored in consumer database 354. As shown in FIG. 8, the first step comprises advertising to consumers 125 the availability of [column 14] free trade publications (step 810). Such advertising can be provided in a number of ways, but the key aspect is introducing and providing the universal questionnaire to a wide variety of consumers.

[Line 18] First, the free trade publication promotion may be advertised on credit card statements. Most consumers who are professionals use credit cards, and therefore may qualify for trade publications. Also, the promotion may be advertised in frequent flyer statements, another good

source because recipients are generally professionals, and many are business travelers. In addition to physical statements, the promotion may also be included as part of the credit card or airline website. Consumers who are attracted to the site will see a message that says: "If you are a professional, you probably qualify for one or more FREE publications about your business. Just answer a few questions to see what business publications you can enjoy, FREE." In this manner, the consumer 125 may be linked directly to the website of central controller 110 from the credit card or airline website. Next, the promotion may be advertised in professional catalogs and as a website link for those catalogs on-line. Again, such catalogs include readers focused in particular industries that are relevant for many trade publications. Finally, the promotion may be advertised on internet and intranet sites (in addition to those previously mentioned) that provide advertising and, depending on the website, are targeted towards professionals. The site provides an easy link to the website of the present invention (and central controller 110). In an alternate embodiment, the site provides a 1-800 number for a potential subscriber to call and contact central controller 110 directly.

Once consumers 125 have come into contact with the website provided by central controller 110, **the central controller 110 transmits the universal questionnaire, receives certain consumer information in response to the universal questionnaire and determines the appropriate free trade publication subscription(s) the consumer 125 may receive (step 820).** The universal questionnaire transmitted in step 820 is described in greater detail below, with reference to FIGS. 9, 10 and 11A-C.

[Line 54] Upon completion of the universal questionnaire, the central controller 110 determines the appropriate trade publications that apply to consumer 125, and notifies consumer 125 that he may receive any or all of them at no charge (step 830). As noted earlier, certain trade publications that consumer 125 qualifies for may not be offered if the internal counter field of magazine database 356 is above the limit specified in the internal counter limit field of magazine database 356. The central controller 110 compares the value in the internal counter field with the value in the internal counter limit field to determine if the trade publication is available. [Emphasis mine.]

Loeb's user responds to a "universal questionnaire" that solicits "certain consumer information" that in no way corresponds to receiving, "from the user, a series of search rules comprising facts about an advertisement" as defined in appellant's specification (Szmanda specification, page 15-16, lines 22-29, 1-9). Rather, Loeb's "universal questionnaire" solicits and the user provides "consumer name, consumer address and e-mail address, consumer profession, consumer title, field of specialty, qualification date and personal identifier" (Loeb, column 7, lines 44-47), none of which corresponds to "facts about an advertisement."

In summary, neither the Skillen document nor the Loeb document discloses the instant claim limitation, expressly or inherently.

Argument 2: Skillen and Loeb do not disclose: "accessing a database comprising details of a plurality of advertisements" (page 13 and 30 of the Appeal Brief). In the Examiner's Answer, the Examiner states the following:

Examiner's Answer, page 11: Skillen discloses that the search engine in the advertising system (col. 2, lines 44 - 45 of Skillen) will search for the match in response to the user query (col. 4, lines 31 - 40 of Skillen). Therefore, the database in Skillen must comprising details of a plurality of advertisements.

Skillen, column 2, lines 44-45: [reproduced supra]

Skillen, column 4, lines 31-40: 2) The search engine 16, having carried out a traditional search of Internet related information in the contextual data 22, passes the argument and results of the its search to the associative search engine 18 which then looks for a match in the **product data 24** of the database 20. The associative search engine 18 may determine a logical product fit to the initial search argument, or it may create a logical tree analysis of possible product fits and selects a probable best product for an advertisement window to be displayed with the search results. [Emphasis mine.]

Nothing contained in the cited matter implies that a response to "the user query" necessarily means that the database being searched comprises "details of a plurality of advertisements."

Indeed, the database specified by Skillen in the above cited matter specifies "product data," consistent with Element 24 of Skillen's Figure 1, labeled a "Product Database." Such a database would most likely contain information about *products* but would not be "a database comprising details of a plurality of advertisements," because products and advertisements for those products are not the same thing.

As for the Loeb document, the Examiner states:

Examiner's answer, page 11: Loeb also discloses that the system also allows to compare the input by the user with the stored value (col. 9, lines 54 - 65, Loeb). Therefore, the database in Loeb also comprises details of a plurality of advertisements."

The citation is reproduced supra. It quite simply does not show a “database comprising details of a plurality of advertisements.” Indeed, no such database is disclosed anywhere in Loeb.

In summary, neither the Skillen document nor the Loeb document discloses the instant claim limitation, expressly or inherently.

Argument 3: Skillen and Loeb do not disclose: "using a search engine to apply said search rules to said database" (page 14 and 31 of the Appeal Brief). The Examiner states that:

Examiner’s answer, pages 11-12: ...Skillen clearly discloses a search engine that allows the user to input the search information (search rules) that comprising the desired information (facts about an advertisement) (See Fig.1, element 16, 18, col. 1, lines 50 - 57, col. 4, lines 29 - 30 of Skillen).

The Examiner’s citation, reproduced supra simply does not show that Skillen’s user inputs “facts about an advertisement.” What Skillen specifies is “desired information.” There is no indication in Skillen that the two are equated. The citation of Figure 1 does nothing to demonstrate that the instant claim limitation is disclosed in Skillen.

The Examiner goes on to cite Loeb, column 9, lines 54-65, reproduced supra. However, nothing in that citation indicates that “facts about an advertisement” are used to search a “database comprising details of a plurality of advertisements.” Rather, what is described is a way in which free magazines are assigned based on “certain consumer information.”

In summary, neither the Skillen document nor the Loeb document discloses the instant claim limitation, expressly or inherently.

Argument 4: Skillen and Loeb do not disclose: "reporting, to the user, results comprising a subset of the contents of said database" (page 14 and 31 of the Appeal Brief). The antecedent basis of “said

database” is “a database comprising details of a plurality of advertisements.” The examiner alleges that the subject matter of the instant claim element can be found in the following citation:

Skillen, column 4, lines 41-47: 3) The associative engine 18 passes the data of the selected product to the search engine 16 which in turn provides the results of the search against the given argument together with the initial product advertisement to the device 12 for displaying to the end user.

Skillen describes a system for delivering the results of a general search query “together with [an] initial product advertisement,” similar to a banner advertisement that might be displayed in a commercial search engine. This is not the same thing as a subset of the database as defined by appellant (Szmanda specification, page 15-16, lines 22-29, 1-9 with further examples given in pp. 3-12).

The Examiner goes on to cite Loeb, column 9, lines 54-65, reproduced supra. However, nothing in that citation discloses a subset of the contents of a “database comprising details of a plurality of advertisements.” Rather, what is described is a way in which free magazines are assigned based on “certain consumer information.”

In summary, neither the Skillen document nor the Loeb document discloses the instant claim limitation, expressly or inherently.

Argument 5: Skillen does not disclose: "querying the user to obtain one or more search rules comprising facts about an advertisement" (page 15 of the Appeal Brief). The Examiner argues:

Examiner’s answer, page 12: By obtaining the user profile and the search rule, Skillen clearly teaches that the system queries the user to obtain one or more search rules comprising facts about an advertisement (col.6, lines 1 - 12 of Skillen).

Skillen, column 6, lines 1-12: ...argument. The associative search engine 40 creates a logical tree analysis of possible product fits, and selects or creates a probable best product advertisement for the advertisement window on the search results. In this case, the associative search engine 40 also can utilize the maintained profile on the end user from past search sessions and/or historical data gathered on their buying habits, in the product selection processing. The associative search engine correlates the user’s identity to data in the user profile database 48 which it maintains and

updates with data (e.g., search argument received with search request) from the current search session.

Neither the cited material nor the Examiner's argument shows that the Skillen reference discloses "querying the user..." The fact that the "associative search engine" uses stored information, such as a "cookie" does not comport with the ordinary meaning of the term "querying." Specifically, the term "query," when used as a verb, is defined as "ask or inquire" (The Oxford Dictionary of Current English, Oxford University Press, New York, 1992). "Querying the user..." is, therefore, not the same thing as reading a "cookie." Further, the stored information contained therein is not disclosed to be "facts about an advertisement," as recited in the claim[s] but rather, a "maintained profile on the end user from past search sessions and/or historical data gathered on their buying habits, in the product selection processing." Appellant has provided a clear example of "querying the user..." in Figure 7 of the instant application.

In addition, neither the Examiner's argument nor the cited matter shows that Skillen discloses "querying the user to obtain one or more search rules comprising facts about an advertisement." As noted supra, nowhere in Skillen does the system solicit nor does the user provide "one or more search rules comprising facts about an advertisement." Accordingly, Skillen does not disclose the instant claim limitation expressly or inherently.

The examiner further alleges:

Examiner's Answer, pages 12-13: Loeb teaches that the advertising can be provided in a number of ways, such as sending a universal questionnaire (col. 9, lines 14 - 44). The questionnaire corresponds to the search rule that is sent to the user in order to querying the user to obtain one or more search rules comprising facts about an advertisement."

The cited matter, reproduced under Argument 1, supra does not show "querying the user to obtain one or more search rules comprising facts about an advertisement." No query involving "facts about an advertisement" is found anywhere in Loeb. Instead, Loeb's "universal questionnaire solicits "certain

consumer information” that in no way corresponds to “querying the user to obtain one or more search rules comprising facts about an advertisement” as defined in appellant’s specification (Szmanda specification, page 15-16, lines 22-29, 1-9). Rather, Loeb’s “universal questionnaire” solicits and the user provides “consumer name, consumer address and e-mail address, consumer profession, consumer title, field of specialty, qualification date and personal identifier” (Loeb, column 7, lines 44-47), none of which corresponds to “facts about an advertisement.”

In summary, neither the Skillen document nor the Loeb document discloses the instant claim limitation, expressly or inherently.

Argument 6: Skillen does not disclose: “using a first search engine to apply said search rules to said database to obtain results comprising a first subset of the contents of said database” (page 17 of the Appeal Brief). Referring to Skillen, Figure 1, the Examiner argues that Skillen discloses two different search engines “to retrieve the result from the database.” However, it is incorrect to refer to “the database” in the singular. There are two databases in the Skillen figure and each is searched by a separate search engine, as shown in Skillen, Figure 1, infra:

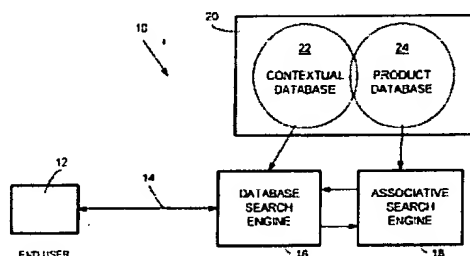


FIG. 1

In the Skillen Figure, the “database search engine” searches the “contextual database” while the “associative search engine” searches the “product database.” The contextual database “typically contains information relating to the Internet, for instance, keywords associated with respective WWW site locations” (Skillen, column 4, lines 11-13), while the “product database” contains “particular product data within the product database 24” (Skillen, column 4, lines 18-19). In contrast, appellant’s

claim recites “said search rules” whose antecedent basis is “search rules comprising facts about an advertisement,” which is not found in Skillen. Further, appellant’s claim recites “said database,” whose antecedent basis is “a database comprising details of a plurality of advertisements.” This database, as defined by appellant, is not the same as the “contextual database” or the “product database” of Skillen, either alone or taken together.

The Examiner’s Answer provides no response regarding whether the instant claim limitation is disclosed in Loeb.

In summary, neither the Skillen document nor the Loeb document discloses the instant claim limitation, expressly or inherently.

Argument 7: Skillen does not disclose: "receiving, from the user, one or more keywords; using said keywords and a second search engine to query said first subset" (Page 17 of the Appeal Brief). The Examiner alleges that the instant claim limitation is disclosed in the following passage in Skillen:

Skillen, column 4, line 29-30: 1) The end user device 12 sends a search request outlining the search argument to the database search engine 16.

However, the instant claim limitation, part of Claim 11, recites “using said keywords and a second search engine to query said first subset” while the “search request” of Skillen is sent to a “search engine, 16” which queries a full database (Skillen, Figure 1, supra), not a “subset.” There is no “subset” disclosed in Skillen. Further, the antecedent basis of “said first subset” is a “first subset of the contents of said database” and the antecedent basis of “said database” is “a database comprising details of a plurality of advertisements.” Skillen’s “search engine 16” searches a “Contextual Database 22” which “typically contains information relating to the Internet, for instance, keywords associated with respective WWW site locations” (Skillen, column 4, lines 11-13).

In summary, the Skillen document does not disclose the instant claim limitation, expressly or inherently.

Argument 8: Skillen does not disclose: "reporting, to the user, results comprising a second subset of the contents of said database, wherein said second subset is smaller than said first subset" (page 18 of the Appeal Brief). The Examiner argues:

Examiner's answer, page 14: ...the user can refine the search result. Therefore, the second result coming back to the user corresponds to the second subset of the contents of said database, and second subset is smaller than said first subset.

However, neither the "contextual database" nor the "product database" of the Skillen document, taken alone or together, is the same as "said database" in the instant claim limitation, whose antecedent basis is "a database comprising details of a plurality of advertisements."

In summary, the Skillen document does not disclose the instant claim limitation, expressly or inherently.

Argument 9: Skillen does not disclose: "receiving, from the user, a first list of keywords; generating a second list of keywords, said second list comprising keywords or phrases synonymously related to one or more keywords or phrase in said first list" (page 19 of the Appeal Brief). Support for this claim limitation is disclosed in Appellant's specification, pages 16-17, lines 27-29, 1-2 and in Figure 4, element 24.

Appellant's Specification, pages 16-17, lines 27-29, 1-2: To generate an expanded list or list of synonyms, such data as is contained in "Partridge's Concise Dictionary of Slang and Unconventional English," Macmillan Publishing Company, New York, (1984 edition), and/or "Roget's International Thesaurus," Robert L. Chapman (Editor), HarperCollins, (1992 edition) can be used.

The examiner argues:

Examiner's Answer, page 14: This operation corresponds to the method that allows the user to enter search argument and then refine the search (see response above). The refine search comprises the search argument or additional search keyword that related to the first result.

Therefore, the refine search argument corresponds to the second list of keywords, said second list comprising keywords or phrases synonymously related to one or more keywords or phrase in said first list.”

As the Examiner’s argument is understood, the result of a first search, presumably of Skillen’s contextual database, will somehow yield a “second list of keywords... comprising keywords or phrases synonymously related to one or more keywords or phrase in said first list.” The examiner does not say how this might happen or why. Indeed, it is highly doubtful that the output of a search proposed by the Examiner (presumably, by searching Skillen’s contextual database) would provide the “second list of keywords... comprising keywords or phrases synonymously related to one or more keywords or phrase in said first list.” The Skillen document is silent about such an outcome and no inherency argument has been made by the Examiner. Notwithstanding, under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). On the contrary, an *expanded* list of “synonymously related” keywords would most likely *not* be produced by a search whose purpose is to *refine*, as in the Skillen document (and as noted by the Examiner), particularly when the databases of Skillen are searched.

Accordingly, the Skillen document does not disclose the instant claim limitation, expressly or inherently.

Argument 10: Skillen and Loeb do not disclose: "receiving a set of search terms comprising words having targeted connotative significance to a particular demographic segment" (page 20 and 33 of the Appeal Brief). The only argument made by the Examiner in alleging that the instant claim element is disclosed in Skillen or in Loeb is the following:

Examiner’s Answer, page 14: The Examiner interpreted the phrase ‘search terms comprising words having targeted connotative significance to a particular demographic segment’ corresponds to the search argument in Skillen and the universal questionnaire in Loeb.”

However, Appellant has on at least two prior occasions asserted his right to be his own lexicographer under *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision"). In Appellant's specification, the term "connotative" was defined in the context of "connotative meaning" (page 9, lines 7-8): "connotative meaning is defined as that which signifies more than the literal meaning of a given word or phrase." Further elaboration was given in that paragraph. Moreover, the relationship between connotative meaning and "a particular demographic segment" is outlined in Appellant's specification (pages 9-10, lines 8-29, 1-3). Neither the concept of "connotative" meaning, nor the concept of a "particular demographic segment" as defined and described by Appellant, appears in the Skillen document.

Similarly, the Loeb document fails to disclose any reference to connotative meaning or how such connotative meaning might relate to "a particular demographic segment."

In summary, neither the Skillen document nor the Loeb document discloses the instant claim limitation, expressly or inherently.

Argument 11: Skillen and Loeb do not disclose: "reporting results of the search comprising a subset of the contents of said database, said results being indexed uniquely" (page 23 and 36 of the Appeal Brief). The Examiner alleges:

Examiner's Reply Brief, page 15: Skillen teaches that the result is presented to the use [sic.] in a predictive order and fashion (col. 2, lines 23 - 30 of Skillen). Therefore, the results are being indexed uniquely.

Skillen, column 2, lines 23-30: Since the process is dynamic the strategy and tactics can be continually refined and the results presented to the end user in a predictive order and fashion that relates to that end user's past preferences (either for the immediate search underway or including all prior search data stored for that user) and a contextual database. This effectively provides

unobtrusive related and useful data and options to the end user who is searching for information.
The processor used...

In other words, based on past searches of the contextual database, the above passage indicates that advertisements can be presented in “predictive order,” “...either for the immediate search underway or including all prior search data stored for that user.” However, appellant’s specification provides a definition and description of the way in which the indexing feature is used in the instant application:

Appellant’s Specification, page 18, lines 3-7: In iterative searches, results are indexed with a unique identifier denoting each of several unique lists of search terms. Such results can, for example, be used to map demographic audiences, targeted in each iteration, to the corresponding search results so that the advertiser can evaluate his or her advertising coverage or that of his or her competitor.

The “predictive order” described in the Skillen document appears to refer to the *timing* of an advertisement presented as a result of past and, possibly, present searches. This in no way comports with the definition and description supplied in Appellant’s specification.

In summary, the Skillen document does not disclose the instant claim limitation, expressly or inherently. The Examiner has made no showing whatsoever that the instant claim limitation is disclosed in Loeb.

Accordingly, neither the Skillen document nor the Loeb document has been shown to disclose the instant claim limitation, expressly or inherently.

Argument 12, Skillen and Loeb do not disclose: "repeating steps (a) - (d) a number of times with at least one different search term in said list, said number being sufficient to cover the desired demographic space" (page 23 and 36 of the Appeal Brief). The Examiner states:

Examiner’s Answer, Page 15: Skillen discloses this technique by allowing the user to refine the search in order to retrieve the desired information.

However, the Examiner has failed to point out how “the desired demographic space” is covered by “allowing the user to refine the search.” Indeed, the act of refining a search, described somewhere in the Skillen document, has the effect of *narrowing* the scope of the search result. On the other hand, the instant claim limitation provides for repeated searches of the “database comprising a plurality of advertisements” “with at least one different search term in said list” in a way that *expands* the scope of the result “to cover the desired demographic space.” Skillen is silent on any aspect of covering “the desired demographic space.” Moreover, Skillen does not disclose repeated searches “with at least one different search term in said list.”

In summary, the Skillen document does not disclose the instant claim limitation, expressly or inherently.

The Examiner has made no showing whatsoever that the instant claim limitation is disclosed in Loeb.

Accordingly, neither the Skillen document nor the Loeb document has been shown to disclose the instant claim limitation, expressly or inherently.

Arguments set forth in Appellant’s Appeal Brief and not addressed by the Examiner: The following is a listing of arguments made in Appellant’s Appeal brief but not addressed by the Examiner. Appellant requests that the Board treat the rejections to which those arguments pertain as having been dropped, per MPEP §1207.02.

Pertaining to Argument 10 (Claims 39 and 42 and claims depending therefrom): The Examiner simply restated an interpretation of the claim terminology that does not comport with Appellant’s lexicography. The Examiner did not attempt to show how the claimed subject matter, involving connotative meaning and its relationship to demographics, as described and defined by Appellant in the specification, is disclosed in either the Skillen or Loeb documents. Moreover, the Examiner did not

proffer any arguments showing why or how Appellant's lexicography is improper. Therefore, Appellant requests respectfully that Examiner's argument be treated as unresponsive and considered as a failure to answer properly the arguments put forth by Appellant.

Pertaining to Arguments 11 and 12 (Claim 42 and claim depending therefrom): While the Examiner gave a response to Appellant's arguments concerning the Skillen document, no response was given to Appellant's arguments concerning the Loeb document. Indeed, throughout prosecution, the Examiner has completely ignored the subject matter of Arguments 11 and 12 as it pertains to the Loeb document, despite Appellant's attempts to point out the omission.

Pertaining to whether the subject matter of dependent Claims 2, 7, 12, 19, 26 and 33 is disclosed in the Skillen document: These claims were argued separately in Appellant's Appeal Brief (pages 23-25) and relate to the prior experience of the user with an advertisement. However, the Examiner completely ignores the arguments set forth in the Appeal brief, despite Appellant pointing out, correctly, that Skillen fails to disclose expressly or inherently any prior experience of the user with an advertisement.

Pertaining to whether the subject matter of dependent Claims 6, 18 and 32 was rejected as being unpatentable over Skillen on proper statutory basis: These claims were argued separately because they were nominally rejected under 35USC §102(b) and the Examiner's arguments pertained to 35USC §103. Notwithstanding, throughout prosecution, Appellant has presented arguments attacking the prima facie cases for anticipation and obviousness, which arguments were consistently ignored by the Examiner, despite several attempts to point out the error.

Pertaining to whether dependent Claims 23 and 37 were properly rejected as being unpatentable over Skillen, despite the fact that the Markush language on which the rejection was based was not recited in the claims: Appellant's arguments in the Appeal brief (pages 26-27) were not addressed by

the Examiner. However, the Markush language on which the rejections were based is not contained in the claims which recite that the “algorithm of said first search engine is the same as the algorithm of said second search engine.” Claim 16 recites the same subject matter but was inadvertently omitted from the list.

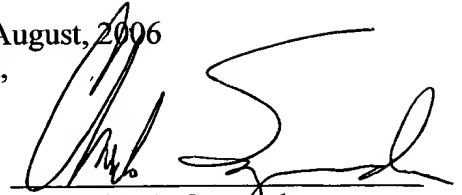
Pertaining to whether dependent claims 2 and 7 are properly rejected as being unpatentable over Loeb under 35USC §102(e): Appellant’s arguments in the Appeal Brief (pages 36-37) received no response from the Examiner. Indeed, no response has ever been received from the Examiner regarding Appellant’s arguments pertaining to the instant claims.

Pertaining to whether dependent claims 4, 9, 41 and 44 are properly rejected as being unpatentable over Loeb under 35USC §102(e): Appellant’s arguments in the Appeal Brief (pages 37-38) received no response from the Examiner. Indeed, no substantive response (see Examiner’s second, final office action, page 10) has ever been received from the Examiner regarding Appellant’s arguments pertaining to the instant claims.

Pertaining to whether Independent Claims 11 and 25 and claims depending therefrom are properly rejected as being unpatentable over Loeb under 35USC §103: Arguments set forth in Appellant’s Appeal Brief (pages 39-44) were not addressed by the Examiner. Moreover, Appellant’s arguments regarding the rejection of Claims 11 and 25 as being unpatentable under 35USC §103 over Loeb have been ignored by the Examiner throughout prosecution despite Appellant’s attempts to point out the error.

For the reasons set forth above and on record in this case, Appellant respectfully suggests that the rejections of Claims 1-42 and 44 are improper and should be reversed, which action is earnestly solicited.

Dated this 26th day of August, 2006
Respectfully submitted,

A handwritten signature in black ink, appearing to read 'C. Szmanda', is written over a horizontal line.

Charles R. Szmanda
Agent for Appellant
Registration # 48,618
Telephone: 508 836 4143
FAX: 508 836 4143